

REMARKS

In the Office Action dated March 21, 2006, the Examiner rejected claims 1-3, 7, 10-24, 28, 31-36, 38-45, 49, 52-57, and 59-63 under 35 U.S.C. § 102(e) as being anticipated by Walker (U.S. Patent No. 6,196,458); and rejected claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58 under 35 U.S.C. § 103(a) as being unpatentable over Walker and Dicker (US. Patent Application Publication No. 2003/0105682). Applicants amend claims 34 and 53 for minor informalities.

Rejection Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1-3, 7, 10-24, 28, 31-36, 38-45, 49, 52-57, and 59-63 under 35 U.S.C. § 102(e) as anticipated by Walker.

In order to properly establish that Walker anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the claim." See M.P.E.P. § 2131. Here, Walker does not teach each and every element of the claims, and thus the Examiner's rejection under 35 U.S.C. § 102(e) is improper.

Independent claims 1, 22, and 43 recite, *inter alia*, identifying "for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index, wherein the product information in the index associates at least a portion of the received purchasing data with a particular product," and modifying "the received purchasing data to include data representing the identified product."

The Examiner cites column 5, lines 34-39, of Walker for an alleged teaching of the above claim limitations. Applicants disagree. The cited portions of Walker describe that “for each account holder, the central controller 12 (i) receives and stores billing items generated by transactions (e.g., purchases) on the account holder’s account; (ii) determines if the billing items satisfy any upsell offer conditions stored in the upsell database 30,” and “(iii) if the billing items satisfy an upsell offer condition, determines an upsell corresponding to the upsell offer condition, and prints onto the billing statement indicia that specifies the upsell.” (Col. 5, ll. 33-41; see also col. 6, ll. 49-51, col. 6, ll. 53-65). Walker, thus, does not “identify, for each transaction, a product related to the transaction,” as claimed. It describes, rather, identifying an “upsell” based on a customer’s purchase transactions.

Further, because Walker does not even disclose identifying a product related to each transaction, it is entirely remote from the teaching of modifying “the received purchasing data to include data representing the identified product,” as recited in claims 1, 22, and 43. The Walker system only prints upsells on the billing statement. It does not, for instance, modify the transaction data itself to include data representing the identified upsell. In fact, the Examiner has pointed to nothing in Walker describing that the billing items received by the Walker system are ever modified.

Therefore, for the reasons above, Walker fails to teach or suggest identifying, “for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index, wherein the product information in the index associates at least a portion of the received purchasing data with a particular product; [and] modifying the received purchasing data to include data

representing the identified product,” as recited in claims 1, 22, and 43. The Examiner should thus withdraw the 35 U.S.C. § 102(e) rejection of claims 1, 22, and 43. The rejection of claims 2-3, 10-21, 28, 31-36, 38-42, 44-45, 49, 52-57, and 59-63 should also be withdrawn, at least by virtue of the respective dependency of these claims from one of claims 1, 22, and 43.

Rejection Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58 under 35 U.S.C. § 103(a) as being unpatentable over Walker and Dicker.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, the prior art reference(s), taken alone or combined, must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

At a minimum, Applicants submit that the Examiner cannot establish that the cited prior art teaches or suggests each and every limitation of the claims. See M.P.E.P. § 2143.01. As discussed above, Walker fails to teach or suggest the features of claims 1, 22, and 43, including identifying “for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index, wherein the product information in the index associates at least a portion of the received purchasing data with a particular product; [and] modifying the received purchasing data to include data representing the identified product.”

The Examiner cites Dicker only for its teaching of “weight values.” (Office Action, page 7). Indeed, Dicker does not cure the above deficiencies of Walker—namely, identifying, “for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index, wherein the product information in the index associates at least a portion of the received purchasing data with a particular product,” and modifying “the received purchasing data to include data representing the identified product,” as recited in claims 1, 22, and 43. Nor does the Examiner assert that Dicker discloses such features.

Accordingly, Walker and Dicker, taken alone or in any proper combination, do not teach or suggest each and every feature recited in Applicants’ claims 1, 22, and 43. The Examiner should thus withdraw the 35 U.S.C. § 103(a) rejection of 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58, each of which depend from one of claims 1, 22, and 43.

Conclusion

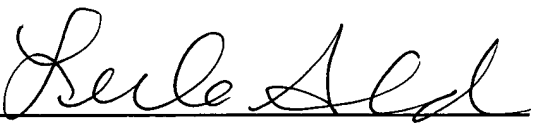
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of pending claims 1-63.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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